

REMARKS

By this amendment, claims 1-29 are pending, in which claim 29 is currently amended, and no claims are canceled, withdrawn, or newly presented. No new matter is introduced.

The final Office Action mailed December 10, 2003 rejected claims 1-6, 8-13, 15-22, and 24-32 under 35 U.S.C. § 102(e) as anticipated by *Oliver* (US 4,839,917), and claims 1-32 under 35 U.S.C. § 103(a) as obvious over *Hedges* (US 3,819,862).

Applicant respectfully submits that claims 30-32 were previously canceled.

Claim 29 has been amended to correct a noted minor cosmetic informality.

Applicant respectfully traverses the rejections under 35 U.S.C. §§ 102 and 103, in that neither *Oliver* nor *Hedges*, singly or in combination, discloses the claimed features.

For example, independent claims 1 and 8 recite “**telephone calls** received by said computer from calling telephones” and “enabling said computer to **verify said identification data against reference data stored in a reference data base.**” Independent claim 29 recites “**placing telephone calls** to a computer system from calling telephones located at various work sites” and “entering at the calling telephones employee identification data associated with employee tracking that is **verified by said computer system against reference data stored in a reference data base.**” Independent claims 9 and 16 include the features of “**telephone calls** received by said computer from calling telephones” and “enabling said computer to **compare the indicated origin of each of said telephone calls with information associated with valid work sites that is stored in a reference data base.**” Further, independent claims 25 and 27 each recites “**receiving telephone calls** by a computer system from calling telephones located at various work sites” and “**comparing the indicated origin of each of said telephone calls with information associated with valid work sites that is stored in a reference data base.**”

By contrast, the *Oliver* system operates not by placement of “telephone calls” in the context of the claims; the Office Action simply reads in the language of “calls” in the rejection without factual support. The Office Action states, “*Oliver* teaches a method and system for personnel tracking (col. 13, ln. 3). **The employee calls from various work locations with their employees PIN** and the call is recorded including the location, employee ID, and the time of the call (i.e., if the employee does not call within a specified time, an alarm is generated). (col. 13, lns. 5-21).” The reference does not in fact use the terms “calls.” At col. 13: 3-18, *Oliver* states:

Employing this option, each employee with duties in the area served by the system may be assigned a personal identification number (PIN). **It typically is a number unused for extensions.** Any time the employee **dials his PIN** from any substation set served by this system, his location is recorded at the monitor station as well as the time of day. This is done by this system **without intervention of the central office switch or PBX switchboard.**

In its normal use, covered personnel merely dial in their PIN number of the nearest telephone set at any time and their location is recorded at the monitor station.

It is clear from this cited passage, upon careful study, that the employee dialing of his PIN, which is performed without intervention of the central office switch or the PBX switchboard cannot be equated to a “telephone call,” in the manner claimed. The dialing of the PIN using the substation set does not constitute a “telephone call.” Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); MPEP § 2111.01. “Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999). In the present case, one of ordinary

skill in the art would not understand a "telephone call" to be dialing digits in a telephone set without intervention of a switch to place the call to be a "telephone call."

This interpretation is consistent with the operation the *Oliver* system. *Oliver* discloses a system for monitoring telephone lines by bridging across each line between a telephone central office or private branch exchange (PBX) and a telephone set. The lines are scanned periodically for OFF-HOOK, DIALING or IN-RING condition to determine line status. OFF-HOOK without DIALING or IN-RING condition for more than a preselected period is considered one form of an alarm condition. Dialing signals of certain predetermined numbers is considered an alarm. A computer is provided to store line status information, preset numbers, personnel identification (PIN) numbers and telephone set locations to provide a universal software controlled monitoring of locations, telephone sets and personnel wherever telephone sets are located. (see Abstract)

Therefore, *Oliver* fails to disclose any computer system **receiving calls from calling telephones** or of **placing calls to a computer system**. Further, the Office Action is silent on these features with respect to *Oliver*. Applicant respectfully submits that these features as recited by each of independent claims 1, 8, 9, 16, 25, 27, and 29 are neither suggested nor disclosed by *Oliver*.

Another feature that is conspicuously absent from *Oliver* is any use of a "reference data base," much less a reference data base used for verifying identification data "**against reference data stored in a reference data base**" as recited in claims 1 and 8 (see similar language in claim 29). Furthermore, *Oliver* has no teaching or suggestion for "**comparing the indicated origin of each of said telephone calls with information associated with valid work sites,**" as positively recited in the noted independent claims 9, 16, 25, and 27. In fact, the Office Action has simply ignored these features in its §102 rejection. (see page 6 of the Office Action).

By not addressing these features, Applicant is left to rely on conjecture for the Office Action's reasoning, in contravention of 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to respond."

In its "Response to Arguments" section, at Page 2, line 22 – Page 3, line 16, the Office Action asserts that "The Examiner respectfully submits that, in order for a personal identification number (PIN) to serve as identification of the person entering a PIN, there must be an understood correlation between the PIN and the person to whom the PIN is assigned (i.e., ideally the person entering the PIN into the system). **It was well understood to one of ordinary skill in the art at the time of Applicant's invention that, once a person enters a PIN, the PIN is matched to an entry in a database (i.e., any collection of data) in order to find the identification corresponding to the entered PIN.**" However, Applicant respectfully submits that MPEP § 2144.03 (E) states:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art **without documentary evidence to support the examiner's conclusion** should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without

evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

Applicant respectfully submits that the anticipatory rejection of the claims is neither properly Officially Noticed nor properly Based Upon Common Knowledge. MPEP § 2144.03, 37 CFR § 1.111(b), *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943) The Office Action does not explicitly mention “Official Notice” or “Common Knowledge,” but instead states, “It was well understood to one of ordinary skill in the art at the time of Applicant’s invention that, once a person enters a PIN, the PIN is matched to an entry in a database (i.e., any collection of data) in order to find the identification corresponding to the entered PIN,” and asserts that certain statements of *Oliver* are “indicative of” the claimed features. The Office Action thus gives no basis whatsoever for any origin of the stated features, thus leaving Applicant without a basis for discussion. Applicant thus respectfully submits that the features which include use of a “reference data base,” much less a reference data base used for verifying identification data **“against reference data stored in a reference data base”** as recited in claims 1 and 8 (see similar language in claim 29), and **“comparing the indicated origin of each of said telephone calls with information associated with valid work sites”**, as positively recited in the noted independent claims 9, 16, 25, and 27, were **not** well understood to one of ordinary skill in the art at the time of Applicant’s invention.

Therefore, the rejection under 35 U.S.C. § 102 is unsustainable, as anticipation requires that each and every element of the claim be disclosed in a prior art reference. Additionally, Applicant respectfully requires documentary evidence to support the Examiner’s conclusion if a next Office Action maintains these rejections, and respectfully requests the withdrawal of finality of the Office Action if the rejection is maintained.

With respect to the obviousness rejection, the Office Action (page 7) again conveniently overlooks the claimed telephone calls and the claimed reference data base in its application of *Hedges*.

Hedges merely discloses a system for indicating the condition of hotel rooms, whereby a portable unit is carried by a maid or other personnel and is adapted to a communication channel. The portable unit identifies the room and the particular portable unit. (Abstract; col. 6: 15-20) The *Hedges* system provides no capability to verify or compare as claimed, and is completely silent on the use of a reference data base. Additionally, *Hedges* (per Abstract) states:

A portable unit is carried by a maid or other personnel and is adapted to be coupled to a **communication channel which may be present for another purpose**. For example, the communication channel **may be the telephone lines which provide telephone service to the rooms**, a television antenna cable, or any other communication channel which is available. The portable unit includes a circuit for transmitting and receiving signals, and switches coupled thereto. When used with a telephone line, the portable units can be coupled thereto through an acoustic coupler, or a receptacle can be provided for the unit which is directly wired to the line. The portable unit or the receptacle can also include a circuit which is uniquely wired or switched to each room, so that a signal can be sent on the line which identifies the room and the particular portable unit, and which provides information representing the operation of the switches of the portable unit. ... The information supplied on the communications line is **coupled to the computer** and stored in the memory thereof, and selectively read out on a visible display and/or printer as desired.

Hedges, at col. 2: 15-22, states that an "object" of its invention is to provide a system which includes "an interface circuit for connecting the unit in a room to the telephone line for applying signals thereto which **do not interfere with the normal use of the telephone lines**." Fig. 1 of *Hedges* shows, emanating from the PBX 27, an "outside line," a "long distance" line, and a "data coupler 29" which is shown coupled to the computer 10. (see col. 2: 43-46) At col. 5: 12-16, *Hedges* states, "The information to be applied to the telephone lines can be provided by audio frequency signals having characteristics such that **they will not interfere with other**

signals present on the telephone lines.” Thus, *Hedges* is merely using telephone lines or other communication channels to enable the portable unit to communicate signals with the computer, and is not using “telephone calls” to communicate with the computer, and the signals do not interfere with the normal use of the telephone lines. Again, one of ordinary skill in the art would not interpret *Hedges*’ use of telephone lines as the claimed “telephone calls.”

Furthermore, with respect to independent claims 17, 24, 26, and 28, claim 17 recites “telephone calls received by said computer from calling telephones at various sites” and “a computer readable program code means **for enabling said computer to compare the indicated origin of each of said telephone calls with information associated with said identification data.**” Independent claim 24 recites “telephone calls received by said computer from calling telephones at various sites” and “computer readable program code means **for enabling said computer to compare the indicated origin of each of said telephone calls with information associated with said identification data.**” Independent claim 26 includes the features of “receiving telephone calls by a computer system from calling telephones located at various sites” and “**comparing the indicated origin of each of said telephone calls with information associated with said identification data.**” Claim 28 recites “means for receiving telephone calls by said computer system from calling telephones located at various sites” and “means for **comparing the indicated origin of each of said telephone calls with information associated with said identification data.**” These features advantageously enable, for example, the validation of telephone calls from preauthorized calling telephones (Specification, page 13, lines 1-18).

In stark contrast, the operation of the *Hedges* system revolves around the use of the portable unit, which provides identification of the room and the person. (Col. 5: 40-43) This disclosure, however, falls short of providing “telephone calls” made to a computer system, or of

“origin of each of said telephone calls,” much less comparing “the indicated origin of each of said telephone calls with information associated with said identification data.” This point is made more evident below in the discussion of the allowability of dependent claims 5, 6, 10-13, 21, and 22.

As regards dependent claims 5, 6, 10-13, 21, and 22, the Office Action acknowledges (page 8) that *Hedges* fails to disclose the use of ANI or caller ID, but nevertheless contends that “Hedges teaches that a device is used to transmit an ID of the telephone set to the computer, the telephone ID being associated with a particular room.” The Office Action further asserts that “This is the same principle on which ANI and caller ID is based,” thereby concluding that “one with ordinary skill in the art would have been motivated to use a well known, more modern technology at the time of the invention to perform the same functionality as taught by Hedges.”

Applicant respectfully disagrees on both points. First, the portable unit of the *Hedges* system does not in fact identify the telephone set, but the portable unit itself and the room (col. 5: 40-43; col. 6: 13-20). Additionally, as discussed above, the portable unit does not make a “telephone call” to the computer system. Therefore, the extrapolation of the functions of the portable unit to ANI and caller ID is technically without merit. As for the second point, Applicant notes that ANI and caller ID are network based services, and are associated with “telephone calls;” thus, the modification that the Office Action is suggesting to *Hedges* is no mere use of modern technology, in that the *Hedges* system provides no suggestion on identifying the room using network services or “telephone calls,” merely contemplating providing such function with the portable unit.

The Office Action of December 10, 2003 (Page 3) states:

Applicant argues that the disclosure of *Hedges* “falls short of providing ‘origin of each of said telephone calls,’ much less comparing ‘the indicated origin of each of said telephone calls with information associated with said identification

data.” (Page 4 of Applicant’s response) Examiner respectfully disagrees. As set forth in the art rejection, Hedges explicitly teaches:

The portable unit includes a receiver 50, a transmitter 52 and a dialer 54, which are shown in block diagram form in FIG. 5. The transmitter 52 includes a circuit which is connected through the connectors 39 and 40 to a unique coding circuit 53 in the particular receptacle 25 to which it is interconnected to provide a room code for identifying the particular room from which a transmission takes place. (*Emphasis added*, Col. 6, lines 15-20)

Clearly, Hedges’ portable unit is understood to be making a call from the particular room in which the transmission takes place; therefore, Hedges does indeed teach the provision of an “origin of each of said telephone calls.”

In response to Applicant’s further arguments regarding *Hedges*, the Office Action (Page 4) states:

Examiner respectfully disagrees. First, Hedges’ portable unit functions as a telephone set since it is used by personnel, such as maids, to communicate (i.e., call in) hotel room status via a telephone network (Abstract). Therefore, the location of the portable unit is understood to be the same as the location of the claimed telephone set. Second, a communication channel comprising telephone lines (as disclosed in Abstract) is a type of network. Furthermore, ANI and caller ID are services specifically offered for telephone number identification (i.e., identification of the telephone unit and location from which a call originates, noting that an area code and address corresponding to a residential phone line both specify locations) via telephone lines. Hedges too provides the identification of the location of a portable unit (i.e., telephone unit) from which a communication (i.e., a call) originates; therefore, Examiner maintains that ANI and caller ID technology indeed exemplify mere uses of analogous modern technology, especially in light of the fact that Hedges was filed in 1972 – eighteen years before Applicant’s earliest priority date of 1990.

However, Applicant respectfully submits that neither *Oliver* nor *Hedges* suggests or discloses “telephone calls” made to a computer system, nor the verification or comparison as discussed above and as positively recited by the combinations of features of any of the claims as discussed above.

Additionally, the Office Action’s repeated reference to “Official Notice that it was notoriously old and well known” e.g., at Page 7: 10, Page 7: 17, Page 7: 20-21, Page 8: 12, and

Page 9: 1 (“well known, more modern technology”) contravenes MPEP § 2144.03, 37 CFR § 1.111(b), *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943) as discussed previously. Therefore, Applicant respectfully requires specific documentary evidence to support such assertions, and requests that if a next Office Action maintains the rejection of these claims, that the next Office Action be made non-final to give Applicant a fair opportunity to respond.

Thus, the rejection of dependent claims 2-7, 10-15, and 18-23 should be withdrawn for at least the same reasons as those discussed above with regard to their respective independent claims, and these claims are separately patentable on their own merits.

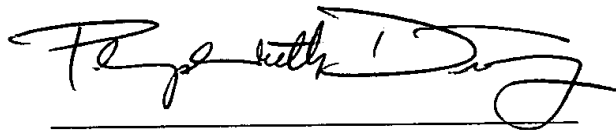
Therefore, Applicant respectfully requests that the rejections of claims 1-29 be withdrawn.

Therefore, the present application overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-6499 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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2/10/04
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